

REMARKS/DISCUSSION:

This Amendment A is being filed within three months after the shortened statutory period for response that ended on December 12, 2006. Accordingly, a Petition for a Three-Month Extension of Time is made a part of the e-file process.

By this Amendment A, claims 1-2 and 4-8 are pending in this application. Claim 1 has been amended in part to include the subject matter of claim 3. Support for the amendment can be found at paragraph [0015] and Fig. 3.

Amendment and/or cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicants have carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Rejection under 35 U.S.C. § 102(e)

Claims 1-7 stand rejected as being anticipated by each of U.S. Patent No. 6,746,402 to Ustuner.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicants submit that the above reference fails to anticipate amended independent claim 1.

The Examiner states that Ustuner discloses a fingertip-mounted minimally invasive surgical instrument and method as noted in the Office Action. Ustuner, however, fails to disclose or suggest a tactile feedback transducer positioned within the cavity for contact with the fingertip as now recited in independent claims 1 and 5. Reconsideration of the rejection is requested.

Claims 2 and 4 depend from claim 1 and claims 6 and 7 depend from claim 5. Applicants submit that these claims are likewise patentable over the cited references for at least the same reasons as discussed above with respect to claim, by virtue of their dependency from claim 1. Withdrawal of the rejections as to these claims is likewise requested.

Rejection under 35 U.S.C. § 103(a)

Claims 8 stand rejected as being unpatentable over Ustuner in view of Seward (7,037,270). Claim 8 depends from claim 5 and is therefore patentable by virtue of its dependency upon claim 5. Further, Applicants submit the following as reasons for patentability.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicants submit that the combined art of record fails to render the claims obvious. In particular, Applicants note that the combination of references fails to teach or suggest all of the limitations of claim 8 in accordance with MPEP 2143.03.

For instance, Applicants submit that the combined art of record fails to teach or suggest all of the limitations recited in claim 8. In particular, Applicants are unable to find any hint that the ultrasound system disclosed in Seward is operational for therapeutic purposes. The Examiner suggests that such teaching is located at col. 2, lines 44-53, col 6, lines 35-55. Nowhere in the passages cited by the Examiner or elsewhere in the disclosure is there any suggesting of an ultrasound transducer useful for therapeutic applications. The Seward disclosure is, however, replete with teachings of an ultrasonic transducer for use in visualization. See, for example, col. 3, ln. 3-12; col. 3, ln 61 through col. 4, ln. 17; col. 5, ln. 64 through col. 6, ln. 18; and col. 6, ln. 34-54. Accordingly, the combined art of record fails to render independent claim 8 obvious in accordance with MPEP 2143.03. Applicants therefore respectfully request that the rejections be withdrawn.

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Conclusion

Applicants submit that in view of the discussion, the rejections under 35 U.S.C. §§ 102(e) and 103(a) have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END-5015/VEK.

Respectfully submitted,

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